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# In the Supreme Court of the United States

OCTOBER TERM, 1944

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No. 738

MINNESOTA MINING & MANUFACTURING COMPANY,  
PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE DISTRICT OF  
COLUMBIA

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BRIEF FOR THE RESPONDENT IN OPPOSITION

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## OPINION BELOW

The District Court of the United States for the District of Columbia did not render an opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 417-419) is reported in 145 F. (2d) 25.

## JURISDICTION

The judgments of the District Court were entered on December 1, 1942 (R. 16, 159). Motions to open the judgment and reconsider the cause,

and motions for additional and corrected findings were denied on January 4, 1943 (R. 16-24, 159-165). The judgment of the Court of Appeals was entered on July 10, 1944 (R. 420). A petition for rehearing was denied on September 8, 1944 (R. 426). The petition for a writ of certiorari was filed on December 8, 1944. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

#### QUESTION PRESENTED

In our view, no question is properly presented here since the petition and supporting brief take no issue with any ruling of the District Court or the Court of Appeals but seek to challenge a ruling which neither court made.

#### STATUTE AND REGULATION INVOLVED

The relevant portions of the statute and regulation involved are set forth in the Appendix, pp. 11-12, *infra*.

#### STATEMENT

On December 1, 1933, petitioner's assignor, C. L. Jewett, filed an Original Application in the United States Patent Office, presenting 59 claims covering improvements in colored granulated material particularly suitable for roofing purposes (R. 22, 34-35, 225-245). Following final rejection by the Patent Office of 33 of the claims for

want of invention<sup>1</sup> (R. 257-262), petitioner instituted suit in the United States District Court for the District of Columbia under Section 4915 of the Revised Statutes (35 U. S. C. 63), and secured a decree on July 13, 1939, adjudging that 15 of the rejected claims were patentable (R. 262-263; 28 F. Supp. 80).<sup>2</sup> The Commissioner of Patents then issued a Notice of Allowance of the 15 claims (R. 264-265). Petitioner's assignor thereupon filed two additional applications in the Patent Office: a "Renewal Application" on December 1, 1939, containing the 15 allowed claims and five additional claims,<sup>3</sup> and a "Continuation-in-Part Application" on November 20, 1939, presenting 13 additional claims.<sup>4</sup>

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<sup>1</sup> Some of the rejected claims were also disallowed for want of support in the applicant's disclosure (R. 256-257, 259, 262). Five additional claims were held unsuitable for inclusion in the same application with the other claims (R. 247, 258). The disposition of the remaining claims in the application (apparently increased by amendment to a total of 70, R. 225-245, 247) is not disclosed by the record.

<sup>2</sup> The remaining 18 appealed claims had been withdrawn by petitioner at the trial (R. 263).

<sup>3</sup> "A renewal application is one that, having been allowed and forfeited, is restored to the Office docket by the payment of a new filing fee". Wolcott, *Manual of Patent Office Procedure* (7th ed. 1936), p. 200.

<sup>4</sup> A "Continuation-in-Part Application" is "an application filed during the lifetime of an earlier application by the same applicant, repeating some portion or all of the earlier application, and adding matter not found in the said earlier case". Wolcott, *id.* at p. 199.

The Continuation-in-Part Application (R. 286-311) included two claims which had been copied from an issued patent (claims 8 and 9 of Veazey patent No. 2,142,540) (R. 9, 12). These were rejected in the Patent Office on the ground that they were not supported by the disclosure of the Original Application and had been refused in the R. S. 4915 suit, and that considered apart from the Original Application the claims were "fully met" by the Veazey patent (R. 312-313, 369-372). The remaining 11 claims were also rejected.<sup>5</sup>

The Renewal Application sought renewal of the Original Application with an amendment containing claims not theretofore allowed (R. 265-266). As then amended, the Renewal Application included the 15 claims already held patentable in the R. S. 4915 suit and five new claims, four of which were copied from outstanding patents.<sup>6</sup> After

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<sup>5</sup> For one or more of the following reasons: "vague and indefinite"; defining "the product by the method of making the same"; being "fully" or "substantially met" in outstanding patents (R. 312-315, 369-377). Two of these claims, by which applicant sought to provoke an interference with the Veazey patent, were held unsuitable for that purpose, because more specific than the Veazey claims (R. 377). Four additional claims tendered upon a request for reconsideration were also refused (R. 365).

<sup>6</sup> The four copied claims were taken from: claims 8 and 9 of Veazey patent No. 2,142,540 and claims 13 and 18 of Hillers patent No. 2,070,359 (R. 265-266, 22-30, 35, 263, 157).

rejecting three of the five new claims,<sup>7</sup> the primary examiner ruled that the remaining two new claims (those copied from Hillers) related to a different species of the alleged invention than the 15 claims previously held patentable; that no claim generic to the two different species was allowable; and that therefore an "election of a single species for further prosecution" was required (R. 268).<sup>8</sup> Petitioner then elected to prosecute, not the 15 claims previously adjudged patentable, but the

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<sup>7</sup> The two claims copied from Veazey were rejected "as containing matter not disclosed in the original specification and as unduly broad in view of the original disclosure". The single new uncopied claim was rejected "as fully met" by other outstanding patents, and "as containing new matter" (R. 267-268).

<sup>8</sup> The 15 allowed claims were said to be "directed to an unfused reaction product of clay and sodium silicate" whereas the two claims copied from Hillers were "directed to a fusion product of cryolite, liquid adhesive and coloring agent" (R. 268).

Rule 41 of the Rules of Practice in the Patent Office provides in part that "two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application: *Provided*, That more than one species of an invention, not to exceed three, may be claimed in one application if that application also includes an allowable claim generic to all the claimed species." The rule further provides that where an application contains one or more generic claims, and claims to more than one species thereunder, and the primary examiner rules that no generic claim presented is allowable, the applicant is required "to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable". See Appendix, *infra*, p. 12.

two claims copied from Hillers. In view of such election, the primary examiner rejected 21 claims (including the 15 claims previously held patentable and other claims added by later amendment (R. 29, 273)) as directed to a non-elected species, thus requiring petitioner to file one or more divisional applications for those claims if it still desired to pursue them.<sup>9</sup> The remaining claims were rejected on other grounds.<sup>10</sup> (R. 269-270.)

Following affirmance by the Board of Appeals of the decisions on the Renewal Application and the Continuation-in-Part Application (R. 273-285, 377-382), petitioner instituted two separate suits against the Commissioner of Patents under R. S. 4915 in the United States District Court for the District of Columbia, praying, in each case, for a decree that petitioner was entitled to a patent for the rejected claims and directing the Commissioner to allow those claims (R. 9, 33). Both cases were consolidated for trial (R. 37), and after receiving in evidence the record before the Patent Office and additional evidence on behalf of petitioner (R. 37-154), the District Court

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<sup>9</sup> The rejection of a non-elected species of claims under Rule 41 merely means that those claims cannot be prosecuted in the same application with the elected species of claims. It is not a ruling on the patentability of the rejected claims.

<sup>10</sup> While the precise number of claims so rejected does not appear from the record, the grounds for their rejection included: non-elected species; unpatentable over outstanding patents; and rejection of similar claims by the Board of Appeals when considering the Continuation-in-Part Application (R. 269-270).



entered findings of fact and conclusions of law (R. 13-16, 155-158), and on December 1, 1942 ordered that the complaint in each case be dismissed (R. 16, 159). In the action covering the claims involved in the Continuation-in-Part Application, the District Court held that all the claims urged were "unpatentable in view of the prior art," and that the two claims copied from Veazey were anticipated by outstanding patents and were not supported by the disclosure of the Original Application (R. 13-15).<sup>11</sup> In the action based on the Renewal Application, the District Court held that petitioner was not entitled to a patent for any of the claims in suit, concluding that 21 of them (including the 15 held patentable in the first suit under R. S. 4915) were properly rejected as drawn to non-elected species (R. 155-158).<sup>12</sup> On appeal, the United States Court of

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<sup>11</sup> Certain of the claims were also rejected for one or more of the following grounds: want of support in the disclosure; anticipation in outstanding patents; being wholly dependent upon process steps; failure to show that the invention was completed by the applicant in any form at any time prior to the filing date of the Continuation-in-Part application or that the applicant exercised reasonable diligence in attempting to reduce such invention to practice at any time prior to that time (R. 15).

<sup>12</sup> The remaining claims (other than those abandoned at the trial) were held unpatentable on one or more of the following grounds: lack of support in the disclosure; unpatentable over outstanding patents; and being "alternative" (R. 157-158).

Appeals for the District of Columbia affirmed both judgments (R. 420).

#### ARGUMENT

The petition for certiorari and brief in support thereof do not specify as error nor argue any of the multiple grounds upon which the Patent Office and the two courts below denied all of petitioner's claims. The petition and brief are devoted entirely to the assertion that the court below affirmed the dismissal of the complaints for want of jurisdiction, as in *Hoover Co. v. Coc*, 144 F. (2d) 514 (App. D. C.), certiorari granted November 6, 1944 (No. 486, this Term), and they argue that this was error.

This utterly misrepresents the decisions below, for the opinion of the court clearly shows that the judgments of the District Court were affirmed on the merits, and were not dismissed for want of jurisdiction. The court below viewed the rejected claims in both cases as seeking in substance "to enlarge the scope of a patent on a single discovery beyond what was allowed by the former decision of the District Court" (R. 418). Observing that "The situation is the familiar one where an applicant seeks a patent right on a general formula and in addition a patent right on each ingredient in the formula," the court below concluded (R. 418-419) that "Here we have no information as to the effect on the building trades of giving the

plaintiff separate patent rights on the use of particular ingredients in addition to its general patent right on the use of all of them together," and therefore affirmed the judgments below, citing *Monsanto Chemical Co. v. Coe*, 145 F. (2d) 18 (App. D. C.).<sup>13</sup> Indeed, far from disclaiming jurisdiction under the rule enunciated in the *Hoover* case, the court below expressly stated (R. 418):

A few of the claims are copied from other applications which were filed later than the original application in this case. It is not clear that the doctrine of *Hoover Co. v. Coe* (No. 8602, decided this day), applies to these claims because it may be that if they were held to be patentable the record contains enough evidence to show that the plaintiff was prior in time without the necessity of further interference proceedings. It is unnecessary to decide this question because the appeal involves a number of similar claims which were not copied.

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<sup>13</sup> In the *Monsanto* case, the court below held that in reviewing a determination by the Patent Office rejecting some claims but allowing other claims in an application, the dissatisfied applicant has the burden of proving by "expert evidence, at least some portion of which should be from disinterested witnesses" that the allowance of the rejected claims in addition to the claims already allowed, would not give such control over the particular industry involved as to impede the progress of the art. 145 F. (2d) at 24.

Accordingly, it is completely erroneous to suggest that the court below relied upon the *Hoover* case or dismissed the appeals for want of jurisdiction.<sup>14</sup>

#### CONCLUSION

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

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JANUARY 1945.

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<sup>14</sup> Answering the petitioner's contention that the claims held to be too broad in scope in the Patent Office had nevertheless been allowed to Veazey, the court below held that the situation would not be improved "by a second mistake" allowing the same claims to petitioner (R. 424).

